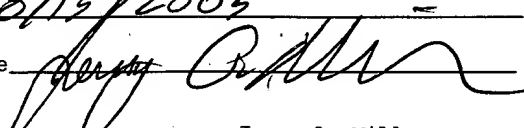
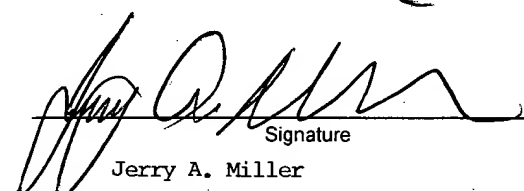


Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

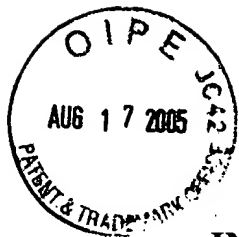
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		SNY - P 3 9 6 5	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>8/15/2005</u> Signature <u></u> Typed or printed name <u>Jerry A. Miller</u>		Application Number	Filed
		09/686,120	10/11/2000
		First Named Inventor	
		Tsang, et al.	
		Art Unit	Examiner
		2611	Saltarelli
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Jerry A. Miller	
		Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>30779</u>		919-816-9981	
		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>8/15/2005</u>	
		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:

Inventor(s) : Tsang, et al
Filed : 10/11/2000
Serial No. : 09/686,120
Confirmation No. : 4933
Group Art Unit : 2611
Examiner : Saltarelli, Dominic D.
Docket Number : SNY-P3965
Title : IP Address Discovery for Cable Modem in Set Top Box

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING / FAX TRANSMISSION

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☒ deposited with the U.S. Postal Service as first class mail with sufficient postage in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Applicant, Assignee or Reg. Representative: Jerry A. Miller, Reg. No. 30779

Signature: 

Date: 8/15/2005

PRE-APPEAL BRIEF REMARKS

Sir:

The current Final Office Action asserts in the paragraph spanning page 3 and 4 that "*(when both a client device and an attached cable modem are initialized, external modems periodically transmit a 'heartbeat' signal over the interconnection which constantly updates the client device regarding the state of the modem, wherein said 'heartbeat' signal includes the most recent IP address assigned to the modem by the DHCP server 110)*".

Serial No.: 09/686,120

This rejection is fatally flawed for at least the following reasons:

- The Office Action never cites a passage of Lim or any other reference of record to support this assertion, and the undersigned can find no such teaching.
- The Lim reference never even uses the word “heartbeat”.
- The only relevance of Lim seems to be that Lim shows a cable modem connected to a PC, and discusses a DHCP assigning IP addresses. The reference is totally silent on how a PC learns the IP address of a cable modem used for communication between the PC and the cable modem. While Lim discusses use of a DHCP request to obtain an IP address from the DHCP server, there is no relevant teaching whatsoever of the subject matter of Applicant’s claims.

The Office Action further asserts (second paragraph of item #4) that the “*main circuit board determines IP address of the modem (also an inherent feature...)*”. Applicants submit that such is not inherent and even if it were inherent, there is no teaching in Lim adequate to meet most of the other claim limitations.

MPEP 1112-IV states that an Examiner must provide a rationale or evidence showing inherency. No such rationale or evidence has been presented; we are left with a bare allegation. Applicants submit that the allegation is false. Evidence submitted herewith from “Robin Walker’s Cable Modem Pages” indicates that in most circumstances, the main circuit board would have no reason to “determine” the IP address of a modem, since the standard address of 192.168.100.1 could be used to communicate with the modem. Other mechanisms are discussed for determination of a cable modem IP address in other circumstances – none of which meet the claim features. Thus, the broad assertion made in the Office Action is not supported by the evidence and an unsupported rejection based on inherency cannot be upheld.

Consider the following analysis of claim 1, by way of example and not limitation (bearing in mind that each and every word of the claims must be considered in making a determination regarding patentability). This analysis is restricted to claim features asserted to be shown in Lim, since the secondary reference is only submitted to show a cable modem in a set top box:

	CLAIM 1	REMARKS
1	In a Set-Top Box configured with a modem and a Main Circuit Board where the Main Circuit Board is connected to the modem via an interconnection, a method of enabling the Main Circuit Board to determine the IP address of the modem, comprising:	Lim is silent about how the modem obtains the IP address of the cable modem.
2	at the modem: periodically broadcasting a Discovery Packet over the interconnection from the modem to the Main Circuit Board, by addressing the Discovery Packet to a broadcast address that can be received by the Main Circuit Board, the Discovery Packet comprising at least the IP address of the modem in order to permit the Main Circuit Board to learn the modem's IP address;	No disclosure of a discovery packet in Lim. No disclosure of a broadcast address in Lim. No disclosure of a broadcast discovery packet containing an IP address. No disclosure of a discovery packet being addressed to a broadcast address of the main circuit board. No disclosure of <u>periodic</u> broadcast of such discovery packet.
3	And at the Main Circuit Board: monitoring the interconnection for receipt of broadcast Discovery Packets addressed to the broadcast address;	No disclosure in Lim of monitoring an interconnection for a broadcast Discovery packet
4	receiving the broadcast Discovery Packet addressed to the broadcast address at the Main Circuit Board from the modem over the interconnection; and	No disclosure of receiving a discovery packet in Lim. No disclosure of a broadcast address at the main circuit board in Lim. No disclosure of a broadcast discovery packet being addressed to a broadcast address of the main circuit board.
5	Ascertaining the IP address of the modem from the broadcast Discovery Packet.	No disclosure of any mechanism for a main circuit board to ascertain an IP address in Lim.

Similar arguments can be made for each of the other claims.

In view of the above, it is clear that there currently exists no sustainable rejection of record. Lim fails to teach practically every feature of claim 1. Applicants accordingly request that the present application be allowed or passed to the Board of Appeals and Interferences for final resolution.

Further Remarks:

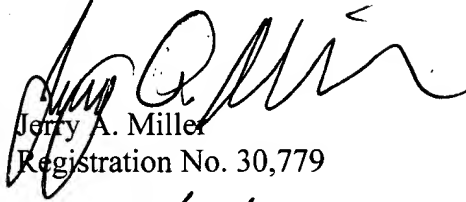
While the above is fully adequate to overcome the current final rejection, Applicants wish to address issues raised during a recent interview. Examiner Tran asserts that all claims are anticipated by a Microsoft reference (which is not been cited and made of record) and therefore since Lim uses addresses obtained from a DHCP server, the claim features are anticipated. If understood, the rationale Mr. Tran apparently used is that on setup or initialization, the cable modem receives an IP address from the DHCP server. If a new IP address is assigned from the DHCP server, the cable modem becomes non-responsive and the user reboots the system (resulting in a new initialization) in order to acquire the new IP address. Applicant has no idea why Mr. Tran considers this relevant to the claims which call out a specific technique for the cable modem to periodically update the main circuit board in the event a new IP address is assigned.

Assuming *arguendo* that Mr. Tran's assertion is correct (not an admission), he still fails to address any of Applicants' claim limitations. Moreover, he seems to contradict the assertion of the present Office Action that alleges that a "heartbeat" signal is periodically transmitted by the cable modem to keep the main circuit board "constantly updated" with the latest assigned IP address. If this were the case, presumably, the period of transmission would be short enough to eliminate failure of the cable modem and the need for the rebooting, which Mr. Tran asserts would cause a re-initialization.

Applicants reiterate that, while Mr. Tran's oral arguments are gratuitously addressed herein even though they have not been formally presented, the Examiner is required under MPEP 2142 to establish a *prima facie* case of unpatentability in which each and every word of the claims is considered. Unsupported assertions of inherency and rejections (or sustaining of rejections) without benefit of citing prior art to support the position is improper, counterproductive and unnecessarily costly to the undersigned's client (and the USPTO's client). Such assertions have resulted in the filing of the present appeal.

All claims are believed clearly allowable and such allowance is respectfully requested at an early date.

Respectfully submitted,



Jerry A. Miller
Registration No. 30,779

Dated: 8/15/2005

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Serial No.: 09/686,120